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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/087,561

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Steven W. Lundberg

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SCHWEGMAN, LUNDBERG & WOESSNER/CPA

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

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3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/087,561	<b>Applicant(s)</b> LUNDBERG ET AL.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-28 and 30-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-28, and 30-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080424</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Request for Continued Examination*

1. The Request filed on 4/24/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/087561 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. Claims 11, 29, and 36 have been cancelled; therefore, Claims 1-10, 12-28, and 30-35 are currently pending in application 10/087,561.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-10, 12-28 and 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Grainger et al. (US 2002/0065677 A1).**
5. As per **independent Claim 1**, Grainger discloses a system for managing information disclosure statement (IDS) references, comprising: a computing system (Fig.1); a first

software component operable on the computing system to generate a plurality of IDS forms (Fig.5, Para 0038-0039, completer and transmit IDS using IDS generation program); and a second software component operable on the computing system to manage IDS references for at least one organization (Fig.3 and 5, IDS storage); and a task managing software component operable on the computing system to manage tasks within matters (Fig 13A – task management system/method for specific cases/matters); and a database comprising IDS references (Fig 8), wherein each organization only has access to its own IDS references (Para 0038, Documents stored in user database; Para 0079-0081, restricted access).

6. As per Claim 2, Grainger discloses a third software component operable on the computing system to provide a presentation for managing the IDS references associated with each matter of the at least one organization (Figs.13A-20).
7. As per Claim 3, Grainger discloses a fourth software component operable on the computing system to manage matters for the at least one organization; wherein the second software component is a part of the fourth software component (Fig.13A, Prior Art associated with Case).
8. As per Claim 4, Grainger discloses a fifth software component operable on the computing system to manage activities within matters; a sixth software component operable on the computing system to manage organizations; an eighth software component operable on the computing system to provide communications; and a ninth software component operable on the computing system to provide security; wherein the third, fourth, fifth, sixth, eighth, and ninth software components are capable of interfacing with the first and second software components in a patent prosecution enterprise application (Figs.13A-20).

9. As per Claim 5, as understood by the Examiner, Grainger discloses wherein a first matter is related to a second matter within the organization by a criteria (Figs.13A-20).
10. As per Claim 6, Grainger discloses wherein the related matters are stored in a storage only accessible to the organization who owns the matters (Para 0081, organizations maintain control of who access their IDS records through access codes).
11. As per Claim 7, Grainger discloses wherein all the matters within the organization are classified (Fig.3A).
12. As per Claim 8, Grainger discloses wherein all the matters within the organization are classified by status of a patent application, which is pending, issued, withdrawn, or abandoned (Figs.3A-3B).
13. As per Claim 9, Grainger discloses wherein all the matters within the organization are classified by type of patent application (Figs.3A-3B).
14. As per **independent Claim 10**, Grainger discloses a method for IDS reporting, comprising: receiving a report specification (Electronic File); interpreting the report specification; generating an answer file (converting information format); receiving a plurality of transformations to act on the answer file and an IDS form definition file; and providing an IDS report (Para 0038-0039, Display in IDS form), wherein the IDS report lists IDS references, and the IDS references are only accessible to an organization who has ownership thereof (Para 0081, organizations maintain control of who access their IDS records through access codes).
15. As per Claim 12, Grainger discloses receiving a question file; wherein interpreting the report specification includes reading the question file (Para 0038).

16. As per **independent Claim 13**, Grainger discloses a method for managing information disclosure statement (IDS) references, comprising: receiving a request to add an new information disclosure statement (IDS) reference to a first matter (Fig.5) owned by an organization (Para 0081, organizations maintain control of who access their IDS records through access codes); searching within the organization for all matters related to the first matter (Fig.5, Search for information); and adding the new IDS reference to selected matters related to the first matter (Fig.5, Create form), wherein the method manages the first matter and tasks within the first matter, and the new IDS reference is only accessible to the organization who owns the first matter and the selected matters (Para 0081, organizations maintain control of who access their IDS records through access codes).
17. As per Claim 14, Grainger discloses selecting only those matters related to the first matter with a matter type that supports IDS reference management and only those matters having an appropriate stage (Figs.13A-20).
18. As per Claim 15, Grainger discloses presenting a list of IDS references for a second matter, wherein the second matter is related to the first matter; and indicating the new IDS reference in the list originated in the first matter (Para 0008).
19. As per Claim 16, Grainger discloses indicating the new IDS reference is unmarked and unreviewed (Fig.20)
20. As per **independent Claim 17**, Grainger discloses a system for managing information disclosure statement (IDS) references, comprising: a computing system; a presentation layer operable on the computing system to present an information disclosure statement (IDS) reference inventory system; a business logic layer operable on the computing system to

manage the IDS reference inventory system and to generate IDS forms (IDS processing system); and a data layer operable on the computing system to manage the data associated with the IDS reference inventory system (Fig.11), wherein each organization only has access to its own IDS references (Para 0081, organizations maintain control of who access their IDS records through access codes).

21. As per Claim 18, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; and a file system accessible to the web server; wherein the presentation layer, the business logic layer, and the data layer operate on the web server (Fig.11).
22. As per Claim 19, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; and a database management system accessible to the web server; wherein the presentation layer and the business logic layer operate on the web server and the data layer operates on the database management system (Fig.11).
23. As per Claim 20, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; an application server in communication with the web server; and a database management system in communication with the application server; wherein the presentation layer operates on the web server, the business logic layer operates on the application server, and the data layer operates on the database management system (Fig.11).
24. As per **independent Claim 21**, Grainger discloses a computer-readable medium storing computer-executable instructions for performing a method, the method comprising:

providing a presentation capable of associating at least one information disclosure statements (IDS) reference to at least one matter; and providing a presentation capable of listing each IDS reference associated with each matter (Figs.13A-20), and restricting access to IDS references so that each organization only has access to its own IDS references (Para 0079-0081, restricted access - organizations maintain control of who access their IDS records through access codes).).

25. As per Claim 22, Grainger discloses providing a presentation capable of generating an IDS form for at least one matter (Para 0038-0039).
26. As per Claim 23, Grainger discloses providing a presentation capable of modifying at least one IDS reference associated with at least one matter (Figs.13A-20).
27. As per Claim 24, Grainger discloses providing a presentation capable of deleting at least one IDS reference associated with at least one matter (Figs.13A-20).
28. As per Claim 25, Grainger discloses providing a presentation capable of searching all IDS references associated with one matter (Figs.13A-20).
29. As per Claim 26, Grainger discloses providing a presentation capable of searching all IDS references owned by one organization (Figs.13A-20).
30. As per Claim 27, Grainger discloses providing a presentation capable of marking at least one IDS reference associated with at least one matter (Figs.13A-20).
31. As per Claim 28, Grainger discloses providing a presentation capable of updating a review status of at least one IDS reference associated with at least one matter; and providing a presentation capable of showing the review status of each IDS reference associated with at least one matter (Fig.20)



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32. As per Claim 31, Grainger discloses wherein presentation capabilities for each individual are determined based on their role in a matter and an organization associated with each individual (Para 0079-0081, Restricted Access).
33. As per Claim 32, Grainger discloses providing a presentation capable of uploading a stream of data associated with the at least one IDS reference (Para 0054, Activate Link/Pointer to IDS file).
34. As per Claim 33, Grainger discloses providing a presentation capable of downloading the stream of data associated with the IDS reference (Para 0054, Attach Link/Pointer to IDS file).
35. As per Claim 34, Grainger discloses providing links for various applications capable of opening and displaying the stream of data (Para 0054, Attach Link/Pointer to IDS file).
36. As per Claim 35, Grainger discloses providing a presentation capable of uploading a plurality of streams of data associated with IDS references, the IDS references being associated with a plurality of matters (Para 0054, Attach Link/Pointer to IDS file).

***Claim Rejections - 35 USC § 103***

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 38. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger in view of Official Notice.**

39. As per Claim 30, Grainger fails to expressly disclose providing an accounting system to track costs associated with storing IDS references.
40. However, one advantage to Grainger's system is the ability to manage costs involved with handling IDS information (Para 0089). Furthermore, Official Notice is taken that the accounting function was a well-known part of doing business when the invention was made, for the purpose of tracking expenses and revenues of a company for owner/stockholder and government/tax reasons (An Example of such Accounting Management can be found in "Cost Management: Accounting & Control" by Don R. Hansen and Maryanne M. Mowen, South-Western College/West; 4 edition, February 21, 2002). Finally, the database costs would be an obvious accounting element to track in such a database intensive system.

***Response to Arguments***

41. Applicant's arguments filed 4/24/2008, with respect to Claims 1-10, 12-28, and 30-35 have been considered but are not persuasive. The rejection will remain as FINAL, based on the cited prior art.
42. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

43. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
44. The Applicant has made the argument that the cited prior art fails to teach or disclose a second software component operable on the computing system to manage IDS references for at least one organization; wherein each organization only has access to its own IDS references.
45. However, Grainger teaches a system with an electronic IDS/electronic document storage component (Para 0038). Grainger also discloses controlling user access rights to the IDS information (Para 0081, organizations maintain control of who access their IDS records through access codes – could be other companies or no other companies the prior art covers both with the disclosed technology).
46. The Applicant has also made the argument that the cited prior art fails to teach or disclose a task managing software component operable on the computing system to manage tasks within matters
47. However, Grainger does disclose a system for managing tasks related to specific cases/matters (Fig.13A).

48. As per the remaining arguments, the Applicant is directed to the rejection above.

***Conclusion***

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

50. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

51. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

May 15, 2008

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629